

On February 17, 2009 the instant renewed petition under 37 CFR 1.137(a) was filed.

STATUTE AND REGULATION

35 U.S.C. § 133 states that:

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

37 CFR 1.113 states in pertinent part that:

(a) On the second or any subsequent examination or consideration the rejection or other action may be made final, whereupon applicant's or patent owner's response is limited to appeal in the case of rejection of any claim (§ 1.191), or to amendment as specified in § 1.116. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (§ 1.181). Response to a final rejection or action must include cancellation of, or appeal from the rejection of, each rejected claim. If any claim stands allowed, the response to a final rejection or action must comply with any requirements or objections to form.

37 CFR 1.116 states that:

(a) After final rejection or action (§ 1.113) amendments may be made canceling claims or complying with any requirement of form which has been made. Amendments presenting rejected claims in better form for consideration on appeal may be admitted. The admission of, or refusal to admit, any amendment after final rejection, and any proceedings relative thereto, shall not operate to relieve the application or patent under reexamination from its condition as subject to appeal or to save the application from abandonment under § 1.135.

(b) If amendments touching the merits of the application or patent under reexamination are presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon a showing of good and sufficient reasons why they are necessary and were not earlier presented.

(c) No amendment can be made as a matter of right in appealed cases. After decision on appeal, amendments can only be made as provided in § 1.198, or to carry into effect a recommendation under § 1.196.

37 CFR 1.135 states in pertinent part:

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

37 CFR 1.137(a) provides:

Unavoidable. Where the delay in reply was unavoidable, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to this paragraph. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional application abandoned for failure to prosecute, the

required reply may be met by the filing of a continuing application. In a Nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;

(2) The petition fee as set forth in § 1.17(l);

(3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (c) of this section.

OPINION

Petitioner requests reconsideration in that the delay in filing a timely response to the final Office action mailed November 18, 2003 was unavoidable due to "inappropriate, unethical, fraudulent, deceitful, and unlawful" conduct of Dr. Lindsey.

The Commissioner may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Commissioner to have been "unavoidable". 35 U.S.C. § 133. Decisions on reviving abandoned applications have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word unavoidable ... is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.²

In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account."³ Finally, a petition to revive an application as unavoidably abandoned cannot be granted where a petitioner has failed to meet his or her burden of establishing the cause of the unavoidable delay.⁴

The showing of record is inadequate to establish unavoidable delay within the meaning of 37 CFR 1.137(a). Specifically, an application is "unavoidably" abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office.⁵

² Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887)(the term "unavoidable" "is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business"); In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

³ Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982).

⁴ Haines v. Quigg, 673 F. Supp. 314, 5 USPQ2d 1130 (N.D. Ind. 1987).

⁵ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

The record shows that there were three parties involved in the prosecution of the instant application at the time of abandonment. Dennis Beach (Beach) was the patent attorney, Jack Illare (Illare) was the Executive of the assignee, Nano Teknologies, LLC (Nano) and Dr. Lindsey (Lindsey), an employee of Nano who was apparently a go-between or liaison between Beech and Illare. Beech was getting instructions from Lindsay although Illare's employment contract specifically stated he was the responsible party for handling all patent matters. Petitioner states time and again that the application went abandoned due to Lindsey's misconduct. Petitioner states that Lindsey assured Illare that the patents were in order when in fact he was not responding to Beech's request for instructions on how to respond to the final Office action. Beech made numerous requests to Lindsey on how to respond to the final Office action. With no instructions forthcoming from Lindsey, Beech elected to take no further action in regard to the final Office action and thus the application became abandoned.

Where the applicant permits a third party to control the prosecution of an application, the third party's decision whether or not to file a reply to avoid abandonment is binding on the applicant. See Winkler, 221 F. at 552, 138 USPQ at 667. Where an applicant enters an agreement with a third party for the third party to take control of the prosecution of an application, the applicant will be considered to have given the third party the right and authority to prosecute the application to avoid abandonment (or not prosecute), unless, by the express terms of the contract between applicant and the third party, the third party is conducting the prosecution of the application for the applicant solely in a fiduciary capacity. See Futures Technology Ltd. V. Quigg, 684 F. Supp. 430, 431, 7 USPQ2d 1588, 1589 (E.D. Va. 1988). Otherwise, the applicant will be considered to have given the third party unbridled discretion to prosecute (or not prosecute) the application to avoid abandonment, and will be bound by the actions or inactions of such third party.

Petitioner argues that Lindsey was not a third party and that Illare's employment contract made it clear he was responsible for all patent matters. The record indicates that, irrespective of any employment agreement, Lindsey was left to make all patent decisions. Beech was totally dependent on Lindsey for instructions on how to proceed in prosecution of the instant application. Illare admits he depended on Lindsey in patent matters because he considered Lindsey very knowledgeable about patents and patent proceedings. The record establishes that Beech knew nothing of Illare's responsibilities in regard to patent matters and Illare did not even know who the patent attorney was for the instant application. Beech and Illare were totally insulated from each other. Illare admits in the renewed petition that he did not know any of the specifics in regard to the instant application to take appropriate action. The record fairly well establishes that Lindsey was in total control of the prosecution of the application, being the only one who was in a position to communicate instructions to Beech, the attorney of record. The record indicates Illare was not in a position to make any patent prosecution decisions in regard to the instant application. Illare depended on Lindsey's expertise, did not know exactly what patent application was subject to his control and apparently was content to not even know who the patent attorney was. The record indicates Illare effectively relinquished control of the

prosecution of the instant application to Lindsey and thus made him the third party. As such, petitioner is bound by the actions (or inactions) of Lindsey.

Furthermore, the record does not show that petitioner was reasonable and prudent in relying upon Lindsey to prosecute the application. Apparently, considerable acrimony existed between Illare and Lindsey with regard to Lindsey's alleged misappropriation of \$400,000. Lindsey, by these actions, had shown that he was not a reliable and trustworthy employee. In fact, the record shows that Illare, despite knowing of Lindsey's actions, failed to properly supervise him. Given these facts and the attendant distrust and acrimony created by this situation, that Illare would believe statements of Lindsey regarding the prosecution of the application without some form of evidence or communication with/from either the USPTO or the patent attorney hired by Lindsey is not the care or diligence generally used and observed by prudent and careful men in relation to their most important business.

Under the circumstances, petitioner has not carried his burden of proof to show that the delay was unavoidable as required by statute and by regulations of the Patent and Trademark Office. Petitioner is reminded that a petition to revive an application under 37 CFR 1.137(a) cannot be granted where a petitioner has failed to meet his burden of establishing unavoidable delay within the meaning of 37 CFR 1.137(a) and 35 USC 133. *Haines V. Quigg*, 673 F. Supp. 314, 5 USPQ2 1130 (N.D. Ind. 1987).

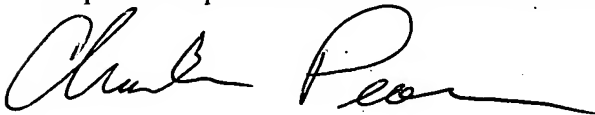
CONCLUSION

For the reasons given above, the delay in this case has not been shown to have been unavoidable within the meaning of 35 USC 133 and 37 CFR 1.137(a).

Accordingly, the application will not be revived under the provisions of 35 U.S.C. 133 and 37 CFR 1.137(a), and the case remains abandoned.

This abandoned file is being forwarded to the Files Repository.

Telephone inquiries related to this decision should be directed to Carl Friedman at 571-272-6842.

A handwritten signature in black ink, appearing to read 'Charles A. Pearson', written in a cursive style.

Charles A. Pearson
Director, Office of Petitions